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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/507,945	02/22/2000	Stephen Williams	200.009255-US(PAR)	2940

7590

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EXAMINER

MUHEBBULLAH, SAJEDA

ART UNIT	PAPER NUMBER
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2174

DATE MAILED: 12/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/507,945

Applicant(s)

WILLIAMS, STEPHEN

Examiner

Sajeda Muhebbullah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on Amendment A 10/21/02.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6, 11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 11 and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. This communication is responsive to Amendment A, filed 10/21/2002.
2. Claims 1-12 are pending in this application. Claims 1 and 4 are independent claims. In the Amendment A, claims 1 and 4 were amended, claims 7-10 were cancelled and claims 11-12 were added. This action is made Final.

### ***Specification***

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Applicant should avoid using the term "means". Appropriate corrections are required.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over King et al. ("King", US 6,011,554) in view of Frederiksen et al. ("Frederiksen", US 6,185,295).

As per claims 1-3, King teaches a communication terminal having:

a display (col.6, line 21);

a keypad for use in the operation of said communication terminal having a plurality of keys associated with several letters each (col.2, lines 63-65);

processor means controlling the display in accordance with the operation of the keypad (col.6, lines 50-52);

a predictive editor program for generating an output containing word matching a received string of ambiguous key strokes (col.3, lines 6-8), said predictive editor program having a number of associated vocabularies including at least one language dependent dictionary and at least one dictionary receiving user defined inputs stored in a first memory which serves said predictive editor program (col.6, lines 58-60; col.22, lines 1-3); and

an editor application controlled by the processor means communicates with said predictive editor programs for generating matching words based on an ambiguous string of key strokes (col.3, lines 6-8).

Furthermore, King teaches the step of copying words into said at least one dictionary for receiving user defined inputs and associated with said predictive editor program from a variety of other sources that can be searched and downloaded to the dictionary (col.22, lines 9-11).

However, King does not explicitly disclose the source to be a second memory means of the communication terminal serving an independent application program for storing user inputted data in an electronic database wherein the memory is an electronic phonebook database stored on a Subscriber Identity Module (SIM) in a cellular phone. Frederiksen teaches a communication terminal comprising a phonebook database stored on an exchangeable SIM card that can be

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copied to the memory of the phone (col.3, lines 47-49; fig.4). It would have been obvious to an artisan at the time of the invention to combine Frederiksen's teaching with King's system in order to expand the dictionary to provide additional matching words.

6. Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over King et al. ("King", US 6,011,554).

As per claims 4, King teaches a communication terminal having:

a display (col.6, line 21);

a keypad having a plurality of keys associated with several letters each (col.2, lines 63-65);

processor means controlling the display in accordance with the operation of the keypad (col.6, lines 50-52);

a predictive editor program for generating an output containing words matching a received string of ambiguous key strokes (col.3, lines 6-8), said predictive editor program having a number of associated vocabularies including at least one language dependent dictionary and at least one dictionary receiving user defined inputs (col.6, lines 58-60; col.22, lines 1-3);

an editor application controlled by the processor means communicates with said predictive editor programs for generating matching words based on an ambiguous string of key strokes (col.3, lines 6-8); and

King teaches an editor application for entering words in an unambiguous form. However, King does not explicitly disclose the editor application to be used to revise, delete, and/or combine words. Official Notice is given that such managing operations for user-defined lists were well

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known in the art at the time of the invention. It would have been obvious to an artisan at the time of the invention to include such managing operations in King's system in order to maintain the user-defined lists of words .

Claim 12 is similar in scope to claim 4, and is therefore rejected under similar rationale.

7. Claims 5-6 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over King et al. ("King", US 6,011,554) in view of Schroeder et al. ("Schroeder", US 5,797,098).

As per claims 5-6 and 11, King teaches a communication terminal wherein said editor application stores words that have to be entered in an unambiguous way in one of said at least one dictionary receiving user defined inputs (col.22, lines 1-7) and teaches the association of a frequency of use to each word (col.13, lines 65-67). However, King fails to teach associated a storing time for the unambiguously entered words stored in the dictionary receiving user defined inputs, updating the storing time every time the word is used, and maintaining the dictionary as a cyclic buffer wherein the word having the oldest storing time is removed from the memory when a new word is added and the buffer is full. Schroeder teaches a communication terminal with a predictive input method wherein a time is associated to each new word, updated each time the word is used (col.7, lines 45-47), and wherein old words are replaced by new words once the buffer is full (col.7, lines 47-50). It would have been obvious to an artisan at the time of the invention to include Schroeder's teaching with King's system in order to make efficient use of the system by freeing up memory for words which are entered most frequently.

#### ***Response to Arguments***

8. Applicant's arguments with respect to claims 4-6 have been considered but are moot in view of the new ground(s) of rejection.

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Applicant's arguments in the Amendment A have been fully considered but they are not persuasive.

Applicants argued the following:

(a) King does not disclose the automatic entry of usable words in its predictive editor dictionary from other application software and uses Frederiksen to remedy this deficiency however there is nothing that would lead to this combination.

The Examiner disagrees for the following reasons:

As per (a), the reference Frederiksen is solely used for the teaching of a phonebook database stored on a SIM in a cellular phone. King teaches the ability to download words from other sources to copy to the dictionary and since Frederiksen's portable SIM card is an external memory that can plug into devices then it would be obvious to combine the references, which would clearly satisfy the claim limitation. Furthermore, King teaches the automatic entry of words into the dictionary which is caused by the user initiating the transfer. In addition, the claim language does not specifically detail the steps involved that would cause the automatic entry.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Inquiries***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sajeda Muhebbullah whose telephone number is (703) 305-3989. The examiner can normally be reached on Monday - Thursday from 7:00 am to 4:30 pm (EST). The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid, can be reached on (703) 308-0640.

The fax number for the organization where this application or proceeding is assigned are as follows:

(703) 746-7238 [After Final Communication]

(703) 746-7239 [Official Communication]

(703) 746-7240 [For status inquiries, Draft Communication]

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Sajeda Muhebbullah  
Patent Examiner  
December 19, 2002

*Kristine Kincaid*  
**KRISTINE KINCAID**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2100**